



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/580,993	05/27/2000	Richard Honea		9849

7590 05/09/2002

Michael J Colitz Jr.
217 Harbor View Lane
Largo, FL 33770

EXAMINER

VERBITSKY, GAIL KAPLAN

ART UNIT	PAPER NUMBER
2859	

DATE MAILED: 05/09/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No. 09/580,993	Applicant(s) Honea
Examiner Gail Verbitsky	Art Unit 2859

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on Feb 12, 2002

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle* 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892)

18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) Other: _____

Art Unit: 2859

DETAILED ACTION

Claim Objections

1. Claim 1 is finally objected to because of the following informalities: Perhaps applicant should add --, the indicia-- after "formed" in line 20 because it is not clear what formed of a heavy markings, the indicia or the side edges. Appropriate correction is required.

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-4, 8-11 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hanrath (U.S. 940873), Fisher (U.S. 5746001), Beeber (U.S. 2994958) and Exhibit 1 by Lufkin [hereinafter Lufkin].

Hanrath discloses in Fig. 1 a tape comprising a sheath of a compound fabric (cloth) *a* of a pre-determined length and thickness having a front face, a rear face, a leading edge, a trailing edge, two parallel side edges, indicia made with equally spaced heavy markings (first distance) in the center (midway) of the front face (continuing indicia), indicia along each side edge (repeating

Art Unit: 2859

indicia). The tape also comprises an insert (strengthening component) **b** secured to the front face interiorly.

Hanrath does not disclose the particular repeating indicia as claimed by applicant, and that the strengthening component being a single thread or a single filament (monofilament) and that heavy markings show foot numerals every 12 inches, and light markings show inches and that the tape may be spooled. Hanrath does not explicitly state that the indices on the edges have different distances (second and third) with respect to each other and the first distance).

Fisher discloses in Fig. 1 a device comprising two sets of repeating indicia at side edges of the device wherein, repeating indicia **A** are spaced from each other at a distance **D2**, and repeating indicia **B** are spaced from each other at a distance **D3**, the distance **D2** and the distance **D3** are not equal (the numerals **A**, **B** and **D3**, **D2** have been added by the Examiner, see attachment to the Office Action).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Hanrath so as to have the repeating indicia on one side edge spaced differently than the repeating indicia on the other side edge of the device, as taught by Fisher, in order to allow the user to use the device for various applications.

Beeber discloses in Fig. 2 a device in the field of applicant's endeavor wherein a strengthening component is a filament (thread) 10 positioned on both sides of the device. The device has two faces, front and rear, whose surfaces are thickened around the filaments.

Art Unit: 2859

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to replace the insert disclosed by Hanrath with two single filaments located on each side of the device, as taught by Beeber in order to provide the same strength to the device by using less material.

Lufkin discloses a device in the field of applicant endeavor comprising a spooled tape having heavy markings with numerals indicating feet measured every 12 inches and light markings indicating inches.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the markings on the device disclosed by Hanrath so as to have markings, as taught by Lufkin, in order to allow the user have a more precise numerical indication of the measurements applicable for the intended use.

It would have also been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Hanrath so as to make the tape capable of being spooled, as taught by Lufkin because the spooled tape will occupy less space when stored.

With respect to the particular length, width and distances (size) of the device and the strengthening component, i.e., 200 feet, 3 inches, 9 and 10 inches, 5 and 5-5/8 inches and 1mm as stated in claims 1, 3, 4 and 1 respectively, the particular size claimed by applicant, absent any criticality, is only considered to be the "optimum" size that a person having ordinary skill in the art at the time the invention was made would have found obvious to provide using routine experimentation based, among other things, on the intended use of the device.

Art Unit: 2859

See In re Boesch, 205 USPQ 215 (CCPA 1980).

With respect to “whereby” as stated in claim 1: It has been held that the functional “whereby” statement does not define any structure and accordingly can not serve to distinguish.

See In re Mason, 114 USPQ 127, 44 CCPA 937 (1957).

4. Claim 5 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hanrath, Fisher, Beeber and Lufkin as applied to claims 1-4, 8-11 above, and further in view of JP 405005601 [hereinafter JP].

Hanrath, Fisher, Beeber and Lufkin disclose the device as stated above in paragraph 3.

They do not disclose that the indicia located on both faces of the tape as stated in claim 5.

JP discloses in Fig. 1 a tape measure having measuring indicia on both, front and rear, faces.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Hanrath, Fisher, Beeber and Lufkin so as to have measuring indicia on both faces, as taught by JP, in order to provide the user with a plurality of different scales and allow the user to use the tape for applications requiring different accuracy.

Art Unit: 2859

5. Claims 6-7 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Hanrath, Fisher, Beeber and Lufkin as applied to claims 1-4, 8-11 above, and further in view of Ward 202610.

Hanrath, Fisher, Beeber and Lufkin disclose the device as stated above in paragraph 3.

They do not disclose that the thread secured to the front face/ one surface of the tape as stated in claim 6-7.

Ward discloses a tape (fabric) whose strengthening component (rubber coating) is located on a face of the tape.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device disclosed by Hanrath, Fisher, Beeber and Lufkin by relocating (shifting) the strengthening component located on top (face) of the tape, as taught by Ward, because it was held that there is no invention in shifting the strengthening component disclosed by Hanrath, Fisher, Beeber and Lufkin to a different position since the operation of the device would not thereby be modified. See In re Japikse, 86 USPQ 70 (CCPA 1950).

Response to Arguments

6. Applicant's arguments filed on February 27, 2002 have been fully considered but they are not persuasive.

Art Unit: 2859

Applicant states that the prior art does not teach “a first indicia extending along the entire length with spacing at a first distance”. However, Hanrath discloses this limitation. As shown in the attachment to the Office Action, the first indicia 1, 2, 3, etc. spaced at a first distance **D1**. Fisher discloses lateral markings (second and third indicia) spaced at a second and third distances respectively. Said second and third distances are different from the first distance of Hanrath.

Applicant states that Fisher’s central markings are not continuous, however, Hanrath’s central markings (1. 2. 3, etc.,) is continuous along the length of the tape. Examiner uses Fisher only to modify the lateral (edge’s) markings. Therefore, the combination of Hanrath and Fisher discloses central markings (indicia) continuous along the length of the tape.

In response to applicant’s argument that there is no suggestion to combine the references, the Examiner recognizes that references can not be arbitrarily combined and that there must be some reason why one skilled in the art would be motivated to make the proposed combination of primary and secondary references. In re Nomiya, 184 USPQ 607 (CCPA 1975). However, there is no requirement that a motivation to make the modification be expressly articulated. The test for combining references is what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. In re McLaughlin, 170 USPQ 209 (CCPA 1971). References are evaluated by what they suggest to one versed in the art, rather than by their specific disclosures. In re Bozek, 163 USPQ 545 (CCPA) 1969. In this case, it would have been obvious to one skilled in the art to modify the device disclosed by Hanrath so as to provide three

Art Unit: 2859

different repeating indicia in order to allow the user to use the tape to make measurement in different systems, metric and customary, as taught by Fisher.

Conclusion

7. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

9. Any inquiry concerning this communication should be directed to the Examiner Verbitsky who can be reached at (703) 306-5473 Monday through Friday, 7:30 to 4:00 ET.

Art Unit: 2859

Any inquiry of general nature should be directed to the Group Receptionist whose telephone number is (703) 308-0956.

GKV



April 23, 2002

Diego Gutierrez

Supervisory Patent Examiner

TC 2800

33-771

Ex.

E7246

J.R.

940.873

Examiner's Copy

T. W. HANRATH.

TAPE MEASURE,

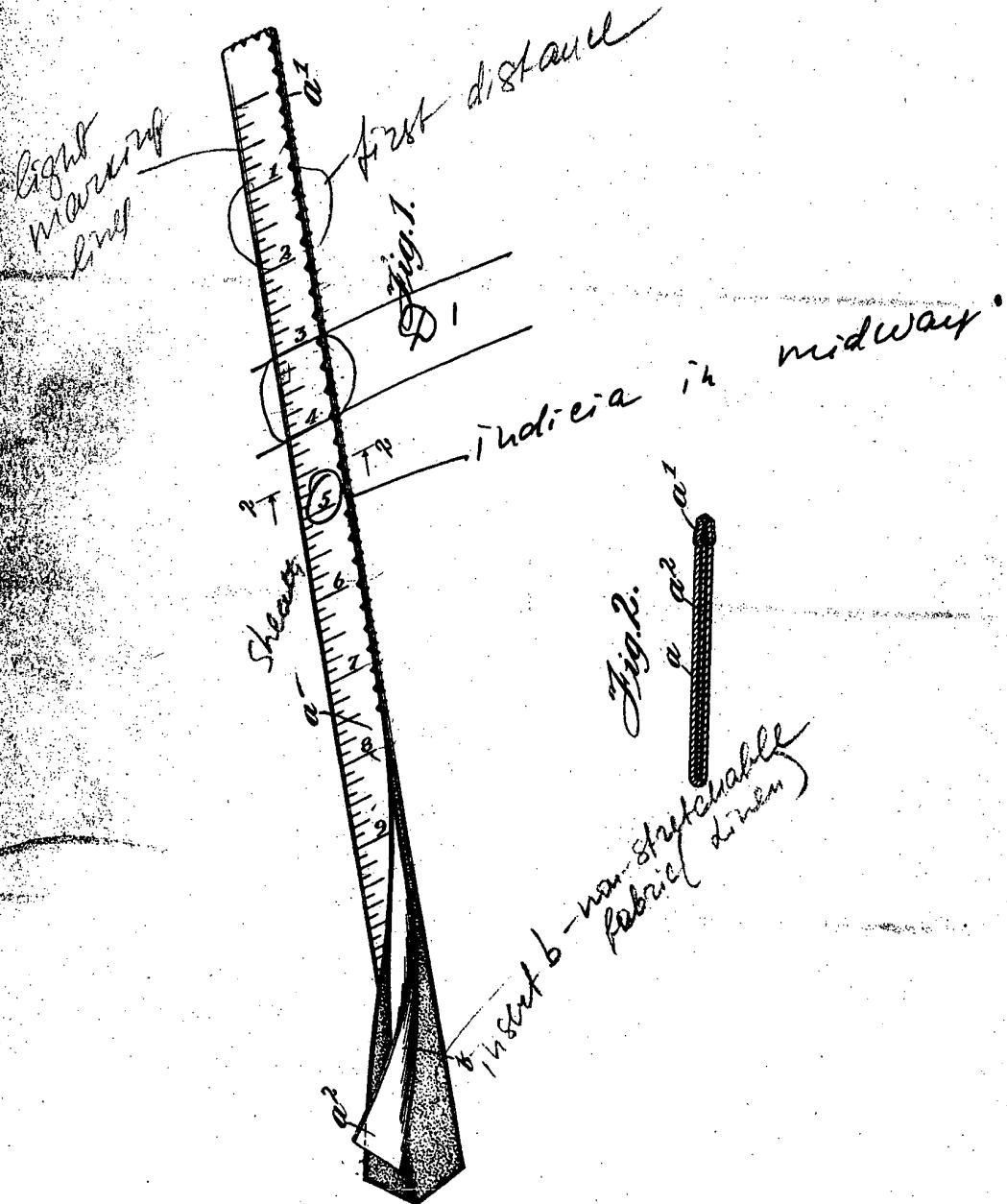
APPLICATION FILED AUG. 24, 1908.

940,873.

Use rubber & stitching
to hold linen insert in
place

See 448 805
for stitching only
09. Steel insert

Patented Nov. 23, 1909.



Witnesses:

Robert
Robert H. T. Morris

Inventor:
Theodore W. Hanrahan

By Cheever & Cox

